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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/650,027

08/27/2003

Fred H. Burbank

R0367.00302

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06/03/2008

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EXAMINER

SZMAL, BRIAN SCOTT

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

06/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/650,027 | Applicant(s) BURBANK ET AL. | |
| | Examiner Brian Szmaj | Art Unit 3736 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-30,32,33,35-38,40-54 and 56-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-30,32,33,35-38,40-54,56,57,63 and 64 is/are allowed.
- 6) ☒ Claim(s) 58-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Terminal Disclaimer

1. The terminal disclaimer filed on March 4, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Pat No 6,758,848 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Specification

2. The abstract of the disclosure is objected to because the submitted abstract on March 4, 2004 still exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 58-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "chord length", when read in light of the Applicants' Remarks filed on March 4, 2008, is not supported by the current specification. Furthermore, the specification does not disclose the term "chord length" anywhere in the specification.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 58, 59, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burbank et al (5,928,164) in view of Tihon et al (5,415,656).

Based on the current specification, the claimed chord length is being interpreted as the arc length for examination purposes.

Burbank et al disclose a biopsy device with a piercing distal tip (45) and further disclose an elongated shaft (44) which has a proximal end and a distal end with a transverse dimension and which has an inner lumen extending within at least a part of a proximal shaft portion; an elongated cutting member (68) having a longitudinal axis and a distal cutting surface which lies in a plane traversing the longitudinal axis; and the elongated cutting member (68) is disposed in part within the elongated shaft (44). See Figure 13A.

Burbank et al however fail to disclose an arcuate cutting electrode which extends over and is secured to the distal end, which is spaced distally from the distal end and which has a chord length greater than the transverse dimension on the distal end; an electrical conductor which has a first end electrically connected to the tissue cutting electrode and which has a second end configured to be connected to a high frequency

electrical power source; and a return electrode effective to provide a return electrical path for electrical current from the tissue cutting electrode.

Tihon et al disclose an electrosurgical apparatus and further disclose an arcuate cutting electrode (18) which extends over and is secured to the distal end, which is spaced distally from the distal end and which has a chord length greater than the transverse dimension on the distal end (the length of the electrode when straightened out is greater than the diameter of the distal end); an electrical conductor which has a first end electrically connected to the tissue cutting electrode and which has a second end configured to be connected to a high frequency electrical power source; and a return electrode effective to provide a return electrical path for electrical current from the tissue cutting electrode. See Column 5, lines 58-64; and Figure 6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the distal tip of Burbank et al to include the use of an electrosurgical cutting electrode for the tip, as per the teachings of Tihon et al, since it is well known in the art to utilize an electrosurgical cutting electrode on a distal tip of a device since it provides a device that causes less trauma while entering the tissue as well as providing a means of hemostasis by cauterizing severed blood vessels.

7. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burbank et al (5,928,164) and Tihon et al (5,415,656) as applied to claim 58 above, and further in view of Klicek (5,221,281).

The combination of Burbank et al and Tihon et al, as discussed above, disclose a biopsy device with an electrosurgical cutting electrode at the distal tip, but fail to disclose the return electrode is contained on the elongated shaft.

Klicek discloses an electrosurgical control for a trocar and further disclose return electrode is contained on the elongated shaft. See Column 7, lines 15-20.

It would have been obvious to one of ordinary skill in the art at the invention was made to modify the combination of Burbank et al and Tihon et al to include the use of a return electrode on the elongated shaft, as per the teachings of Klicek, since it is well known in the art to utilize a bipolar electrode setup in electrosurgical devices since it prevents the use of a large return electrode placed on the patient's back.

Allowable Subject Matter

8. The following is a statement of reasons for the indication of allowable subject matter: Claims 28-30, 32, 33, 35-38, 40-47 are allowable per the reasons set forth in the Office Action mailed on April 12, 2006. Claims 48-54, 56 and 57 remain allowable per the reasons set forth in the Office Action mailed on December 1, 2006. Claim 63 is allowable per the reasons set forth in the Office Action mailed on December 10, 2007.

Response to Arguments

Art Unit: 3736

9. Applicant's arguments filed March 4, 2008 have been fully considered but they are not persuasive. The Applicants argue that the rejection of Burbank ('164) in view of Tihon ('656) does not disclose the chord length being greater than the maximum transverse dimension of the distal end, because of the submitted evidence from "The Machinist's Friend". However, as discussed above, the current specification fails to support the supported definition submitted on March 4, 2008. Therefore the Claims 58-62, added on December 17, 2004 constitute new matter. As discussed above, Claims 58-62 are being rejected under Burbank and Tihon, per the current disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmaj who's telephone number is (571)272-4733. The examiner can normally be reached on Monday-Friday, with second Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian Szmal/
Patent Examiner, Art Unit 3736